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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197504
Party	Defendant Alpha Phi Omega
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

OMEGA, S.A.,

OPPOSER,

v.

ALPHA PHI OMEGA,

APPLICANT.

Opposition Nos.
91197504 (Parent) &
91197505 (Child)

Serial Nos.
77950436 & 77905236

**ALPHA PHI OMEGA’S REPLY TO OMEGA’S OPPOSITION TO
MOTION FOR CONSOLIDATION WITH PROCEEDING NO. 91214449
FOR THE LIMITED PURPOSE OF CONSIDERING CO-PENDING
MOTIONS FOR SUMMARY JUDGMENT**

Opposer Omega, S.A. is perhaps best known as a manufacturer of watches and other time-keeping devices. Its primary consumer products are premium-priced high-end wrist watches selling for thousands of dollars each. *See* Applicant’s Exhibit 1 to Motion. Although various models of Omega Watches can be acquired for “only” a few thousand dollars, many models sell for tens of thousands of dollars. *Id.* at Misc010–016.

The Applicants in the parallel proceedings jointly seeking consolidation for a limited purpose are collegiate fraternal organizations, Alpha Phi Omega, also known as ΑΦΩ, and Alpha Omega Epsilon, also known as ΑΩΕ.

Applicants are not the only fraternities and sororities to coexist with Omega Watch over the years. In addition to these two Greek letter organizations, there apparently are *dozens* of other fraternities and sororities with the Greek letter “Omega” in their name including (1) Alpha Tau **Omega**, (2) Alpha Chi **Omega**, (3) Chi **Omega**, (4) Alpha Gamma **Omega**, (5) **Omega** Chi, (6) Sigma Phi **Omega**, (7) Kappa **Omega** Tau, (8) Gamma Epsilon **Omega**, (9) Beta **Omega** Phi, (10) Sigma Phi **Omega**, (11) Sigma Alpha **Omega**, (12) **Omega** Delta Phi, (13) Alpha Nu

Omega, (14) Lambda Tau **Omega**, (15) **Omega** Chi, (16) **Omega** Phi Beta, (17) Gamma Phi **Omega**, (18) Sigma **Omega** Epsilon, (19) Alpha Pi **Omega**, (20) **Omega** Phi Gamma, (21) Sigma **Omega** Nu, (22) Alpha Sigma **Omega**, (23) Delta Phi **Omega**, (24) Delta Pi **Omega**, (25) **Omega** Chi Psi, (26) Sigma Kappa **Omega**, (27) Sigma **Omega** Phi, (28) Gamma Alpha **Omega**, (29) Alpha **Omega**, (30) **Omega** Tau Sigma, (31) Delta **Omega**, (32) **Omega** Psi Phi, (33) Psi Sigma **Omega**, (34) Alpha **Omega** Sigma, (35) Order of **Omega**, and (36) **Omega** Rho.

Opposer even acknowledges it is aware of the existence of numerous fraternities and sororities with Omega in their names including, Alpha Chi **Omega**, Alpha **Omega** Epsilon, Alpha Phi **Omega**, Alpha Tau **Omega**, Chi **Omega**, Delta Phi **Omega**, Gamma Phi **Omega**, Lambda Tau **Omega**, **Omega** Psi Phi, **Omega** Delta Phi, **Omega** Phi Beta, **Omega** Phi Chi, and Sigma **Omega** Phi. *See* Applicant's Exhibit 2 to Motion (Excerpts of Opposer's response to Alpha Omega Epsilon Interrogatories) at response to Interrogatory No. 12.

Notwithstanding years of coexistence with dozens of fraternities and sororities, Opposer has now decided to bully any collegiate fraternity or sorority with the word Omega in its name. In addition to the AΦΩ and AΩE oppositions, Omega Watch has instituted similar TTAB proceedings against the Omega Psi Phi Fraternity which has coexisted with Omega over 100 years, since 1911 (Proceeding No. 91197082), and the Lambda Tau Omega Sorority (Proceeding No. 91208652). Omega also has unsuccessfully sought an extension to oppose a filing of the Psi Sigma Omega Service Fraternity (Serial No. 78739642) and successfully bullied Omega Delta Phi into abandoning the application to register its name (Proceeding No. 91186613).

1. The Common Issue: An identical of law or fact governs Omega's multiplicity of oppositions to Greek letter organization insignia. The identical issue common to all the Omega versus fraternity and sorority oppositions is whether a consumer of fraternity or sorority affinity

merchandise, primarily college students, will confuse fraternal affinity merchandise with Omega and its premium-priced high-end watches, or will at least associate the merchandise with Opposer or its \$2,000, \$5,000, \$10,000, \$20,000 or \$40,000 Omega watches.

Rather than allow the Board to efficiently and uniformly address and resolve the identical case dispositive issue common to these oppositions, Omega apparently prefers to individually bully the nonprofit Greek letter organizations less capable of funding the battle, a battle tactic which would unnecessarily stress the resources of the Board resulting in separate adjudications—maybe uniform, maybe not—of an identical issue common to the related oppositions. Not only is the issue *identical*, the issue is both (1) case dispositive and (2) *simultaneously ripe* for resolution in both groups of oppositions for which limited consolidation is sought.

The simultaneously ripe case dispositive issue common to both of these oppositions is the question of whether the insignia of Greek letter collegiate fraternities and sororities with the Greek letter “Omega” in their name are likely to be confused with the Omega Watch marks. In applying both case law and a recent ruling by the Board, it is clear *as a matter of law* that multiple Greek letter collegiate fraternity or sorority names and insignia containing the word “Omega” or Greek letter “Ω” are not likely to be confused or associated with either the Omega marks or its premium-priced high-end watches. The dispositive problem with the Omega’s oppositions is the fact that the consumers are conditioned to identify a combination of two or three Greek alphabet letters in a name as a reference to a fraternity or sorority. *Abraham v. Alpha Chi Omega*, 781 F.Supp.2d 396, 410 (N.D.Tx. 2011) *aff’d* 708 F.3d 614 (5th Cir. 2013) *cert. denied*, 134 S.Ct. 88 (2013) (“use of various combinations of Greek letters, in the mind of the public, generally refers to fraternities and sororities”). The Board itself also recently so noted holding that the letters EK on caps is not likely to be confused with the Greek alphabet letters for

the Sigma Kappa Sorority, namely, ΣK, also on caps, because Greek insignia will be “perceived as identifying both Greek letters and the name of a sorority.” *In re New Era Cap Co., Inc.*, No. 85515684, <http://ttabvue.uspto.gov/ttabvue/v?pno=85515684&pty=EXA&eno=21> at p.5 (TTAB July 7, 2014). The Board reached this holding by *reversing a registration refusal* based upon a finding of likely confusion. To do so, the Board necessarily thus held that confusion in such a context is not likely *as a matter of law*.

And that is the identical dispositive issue in the co-pending Motions for Summary Judgment for which consolidation is sought. Resisting consolidation for the limited purpose of resolving the identical issue common to these proceedings, and ignoring both the plain wording of FED. R. CIV. P. § 42, and the case law applying same, Omega wrongly suggests that consolidation is only appropriate in relation to proceedings involving identical parties, identical marks, and identical procedural status. Omega further suggests consolidation is only appropriate when cases are suitable for complete consolidation *all the way through trial*; never appropriate for the limited purpose of consideration of a dispositive common issue. Omega is mistaken.

2. The General Rule: The threshold considerations supporting consolidation are not whether the cases involve identical parties, identical marks, and identical procedural status. The controlling consideration is whether the cases involve, to quote the Rule, “a common question of law or fact.” *Id.* at 42(a). As a leading treatise on civil procedure notes,

The consolidation rule provides...a powerful tool to expedite litigation by drawing together separate actions sharing common legal or factual questions. This managerial device makes possible the streamlined processing of groups of cases.... The articulated standard... *is simply that they involve a ‘common question of law or fact.’*

8 MOORE’S FEDERAL PRACTICE § 42.10[1][a] (2014) (emphasis added). *See also* 9A C. WRIGHT & A MILLER, FEDERAL PRACTICE AND PROCEDURE, § 2384 (2013) (“of course, the basic

requirement of Rule 42(a)” is whether there is a common question of law or fact”). “[A] common question by itself is enough to permit consolidation.” *Id.* at § 2382. “Consolidation ... is a well-established method of promoting judicial economy and convenience in cases where common issues of law or fact exist with respect to two actions.” *Bank of Montreal v. Eagle Assocs.*, 117 F.R.D. 530, 532 (S.D. N.Y. 1987). “The *threshold question* ... is whether common questions of law or fact exist.” *Id.* “If that threshold requirement is met, then whether to grant the motion to consolidate becomes an issue of discretion.” *Pariseau v. Anodyne Healthcare Mgmt., Inc.*, 2006 U.S. Dist. LEXIS 17357, at *4 (W.D. N.C. Feb. 9, 2006).

When the threshold of a common question of law or fact is present, the next question is not whether the cases involve identical parties, identical marks, and identical procedural status, rather, “the question of whether or not to consolidate is one of judicial discretion, in which several factors should be considered.” *Pariseau*, 2006 U.S. Dist. LEXIS 17357, at *5. “[T]he reasons why cases should be consolidated include: (1) the possibility of inconsistent adjudication of common factual and legal issues; (2) the unnecessary burden on parties and witnesses created by separate cases; (3) judicial economy; and (4) additional time requirements and expenses resulting from separate trials.” *See also* TBMP § 511 and *Bank of Montreal*, 117 F.R.D. at 532. Here, each of the considerations counsel in favor of the limited consolidation here sought.

Essentially identical Motions for Summary Judgment are co-pending in both sets of oppositions, both motions based upon the *identical dispositive point* that insignia of Greek letter collegiate fraternities and sororities with the Greek letter “Omega” in their name are, as a matter of law, not likely to be confused with the Omega Watch marks. Because the co-pending Motions for Summary Judgment are in all material respects essentially identical and both present the identical dispositive issue, it would burden the Board to have two distinct panels address the

identical dispositive question of law, and separate adjudication may not result in a uniform adjudication of the identical dispositive question.

Both of the “unrelated” parties, AΦΩ and AΩE share a common interest in the resolution of this issue are not at all burdened or prejudiced by limited consolidation to address the common issue. Without really explaining how, Omega claims it would be “prejudiced” by the limited consolidation. Omega is a bully that after all these scores of years has decided to challenge any Greek letter fraternity or sorority with the word “Omega” in its name. Unless Omega actually desires inconsistent adjudications of the common issue, or desires to churn hours separately attacking the multiplicity of fraternities or sororities with the word “Omega” in their names, how would uniform adjudication of this common issue prejudice Omega?

The common issue is ripe for adjudication. It is the essential focus of both of the co-pending Motions for Summary Judgment. Joint consideration of both motions will not delay these proceeding or otherwise impose any additional time requirements. Omega makes much ado about the ancillary motions pending in both cases, all the while neglecting to acknowledge the ancillary motions are just that, they are ancillary to the principle co-pending Motions for Summary Judgment. Omega further neglects to acknowledge that all the ancillary motions essentially revolve around the same factual information: Omega’s efforts to get the Board to either exclude proof or allow more discovery relating to the undisputable fact that various fraternities and sororities have the word “Omega “ in their names. All of the ancillary motions relate to this point. Pending in the Alpha Phi Omega oppositions (Proceeding No. 91197504 (Parent)) is Omega’s Motion for Reconsideration [D.E. 56] of a Board Order requiring it to properly respond to Requests for Admission as to whether it has any basis for disputing that various fraternities and sororities with Omega in their name provide merchandise for their

members bearing their insignia and have done so dating back to the 1800s; Omega's motion [D.E. 59] to exclude evidence that various fraternities and sororities with Omega in their name provide merchandise for their members bearing their insignia and have done so dating back to the 1800s; and Omega's motion [D.E. 63] to delay consideration of the Motion for Summary Judgment and for additional discovery relating to whether various fraternities and sororities with Omega in their name provide merchandise for their members bearing their insignia and have done so dating back to the 1800s. The ancillary motion pending in the Alpha Omega Epsilon oppositions (Proceeding No. 91214449 (Parent)) is essentially identical, Omega's motion [D.E. 11] to delay consideration of the Motion for Summary Judgment and for additional discovery relating to whether various fraternities and sororities with Omega in their name provide merchandise for their members bearing their insignia and have done so dating back to the 1800s.

The essence of all of these ancillary motions revolves around identical facts which are not even essential to consideration of the co-pending Motions for Summary Judgment. Although Omega wishes to delay consideration of the co-pending Motions for Summary Judgment to engage in a fishing expedition, the prayed for fishing expedition does not at all go to the focal point of the Motions for Summary Judgment, namely, the question of law whether the Greek letter organization marks are recognizable as fraternity and sorority names and thus too dissimilar to Omega's marks as a matter of law. Rather, the prayed for fishing expedition goes not only to indisputable factual background, it relates to information which, as described in our oppositions to each of the ancillary motions, we years ago provided to Opposer as well as information which is readily available in a simple Google or Bing search of "fraternity merchandise," "sorority merchandise," "Alpha Chi Omega merchandise," "Alpha Tau Omega merchandise," or "Chi Omega merchandise." Any such simple searches would direct the

searcher to a wide assortment of Greek products specialty vendors as well as confirm what anyone who attended college is well aware: fraternities and sororities make available a wide assortment of items bearing their insignia for members to acquire and wear or display to reflect membership in their respective fraternity or sorority.

The ancillary motions are just that, they are ancillary to the co-pending Motions for Summary Judgment, essentially involve the identical facts, and thus are quite suitable for consolidated consideration ancillary to consideration of the co-pending Motions for Summary Judgment. All posturing and ranting aside, the proceedings for which limited consolidation is sought revolve around an identical case dispositive issue. The ancillary motions themselves relate to essentially identical information that is not essential to consideration of the co-pending dispositive motions. The ancillary motions at all distract from or interfere with consolidated consideration of the co-pending Motions for Summary Judgment.

Further, for Omega to contend that the proceedings for which limited consolidation is sought are “totally different” procedural junctures is quite misleading. In both proceedings we have filed essentially identical Motions for Summary Judgment grounded on the identical case dispositive point. Omega has resisted both motions seeking additional *unnecessary* discovery. The fact that one of the proceedings is closer to trial than the other whereas the fact that the other proceeding’s procedural status is on the verge of the close of discovery totally misses the point. The issue for which limited consolidation is sought relates only to the common pending motions which are *at identical junctures*. We have not sought consolidation through trial. In the event the Board does not grant summary judgment in both proceedings (an result we believe to be quite unlikely), each proceeding will return to its own procedural track, we have not requested consolidation relating to all issues, through trial.

3. Consolidation for a Limited Purpose is Proper: A primary premise of Omega's objection to consolidation for the limited purpose of considering the pending motions is Omega's mistaken assumption there is no such thing as "limited" consolidation. Omega is mistaken in its contention consolidation is only possible through trial. To so argue overlooks the plain wording of the consolidation rule, consolidation can be for consideration of a single motion or "hearing *or* trial" it can relate to "any or all matters at issue in the actions." Fed. R. Civ. P. 42(a).

"[C]onsolidation may be ordered for less than the entirety of the actions; it may be limited to particular issues in or aspects of the various cases." 9A C. WRIGHT & A MILLER, AT § 2384.

4. Consolidation is not Limited to Cases Involving Identical Parties: Omega further contends that consolidation is improper unless the proceedings involve "identical" parties. Omega is mistaken. "The threshold question ... is whether common questions of law or fact exist." *Bank of Montreal* 117 F.R.D. at 532 . "If that threshold requirement is met, then whether to grant the motion to consolidate becomes an issue of discretion." *Pariseau* 2006 U.S. Dist. LEXIS 17357, at *4 (W.D. N.C. Feb. 9, 2006).

Identity of parties is not controlling. Indeed, as the Board itself instructs, "Although identity of the parties is another factor *considered* by the Board in determining whether consolidation should be ordered, it is not always *necessary*." TBMP § 511. Or as noted in MOORE'S, "Of course, the presence of different parties does not prevent a case from being properly consolidated." 8 MOORE'S FEDERAL PRACTICE § 42.10[6][b] (2014). "Even in multi-party litigation, courts have been quick to emphasize that the danger of confusion from consolidation is largely overstated." Especially in infringement cases *involving unrelated alleged infringers*, consolidation of pre-trial issues is neither improper, nor uncommon. *See e.g., Kohus v. Toys "R" Us, Inc.*, 2006 U.S. Dist. LEXIS 33470, at 3-4 (S.D. Oh. May 25, 2006)

(consolidation of infringement cases against unrelated infringers ordered for pre-trial proceedings).

CONCLUSION

Consolidation is appropriate in situations in which similar proceeding involve a common question of law or fact. The threshold consideration is not whether the proceeding involve identical parties, identical marks, and identical procedural status. Rather, when the proceedings involve a common question of law or fact, the Board then may order consolidation, in whole or in part, when in its discretion it appears that consolidation is desirable in the interest of “judicial economy” and to avoid inconsistent adjudication of common factual and legal issues.

The motion for limited consolidation involves essentially identical Motions for Summary Judgment which are both based upon the *identical dispositive point*: the insignia of Greek letter collegiate fraternities and sororities with the Greek letter “Omega” in their name are, as a matter of law, not likely to be confused with the Omega Watch marks. Because the co-pending Motions for Summary Judgment are in all material respects essentially identical and both present the identical dispositive issue, it would burden the Board to have two distinct panels address the identical dispositive question of law, and would unnecessarily risk inconsistent adjudication of an identical dispositive issue. ACCORDINGLY, the limited consolidation sought is appropriate.

Respectfully requested,

/jackawheat/

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CERTIFICATE OF SERVICE AND ELECTRONIC SUBMISSION

I hereby certify that a true copy of this item, Alpha Phi Omega's Reply To Omega's Opposition To Motion For Consolidation With Proceeding No. 91214449 For The Limited Purpose Of Considering Co-Pending Motions For Summary Judgment is being filed electronically with the U.S. Patent and Trademark Office using the ESTTA service, and a copy has been served on counsel for Opposer by mailing said copy this 18th day of November, 2014, via First Class Mail, postage prepaid, to:

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